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MAR 11 2005

OFFICE OF PETITIONS

In re Application of :
George Eustace Joannou :
Application No. 10/018,308 : **DECISION ON PETITION**
Filed: January 24, 2002 :
Attorney Docket No. JOANNOU :

This is a decision on the petition filed September 24, 2003, pursuant to 37 CFR 1.137(b), to revive the above-identified application.

The petition is **GRANTED**.

The above-identified application became abandoned for failure to time pay the Issue Fee within the statutory period of three months from the mailing date, June 16, 2003, of the Notice of Allowance. This period is not extendable. No Issue Fee having been paid, the above-identified application became abandoned effective September 17, 2003, by operation of law. As the abandonment was not made of record, no Notice of Abandonment was mailed.

On instant petition, petitioner paid the petition fee and made the required statement of unintentional delay. In addition, petitioners submitted a Request for Continued Examination (RCE), the RCE fee, an Information Disclosure Statement and authorization to charge any required fees to their Deposit Account. As stated in MPEP 711.03(c)IIA1:

While the revival of applications abandoned for failure to timely prosecute and for failure to timely pay the issue fee are incorporated together in 37 CFR 1.137, the statutory provisions for the revival of an application abandoned for failure to timely prosecute and for failure to timely submit

the issue fee are mutually exclusive. See Brenner v. Ebbert, 398 F.2d 762, 157 USPQ 609 (D.C. Cir. 1968). 35 U.S.C. 41(a)(7) authorizes the acceptance of an "unintentionally delayed payment of the fee for issuing each patent." Thus, 35 U.S.C. 41(a)(7) and 151 each require payment of the issue fee as a condition of reviving an application abandoned or patent lapsed for failure to pay the issue fee. Therefore, the filing of a continuing application (or request for continued examination) without payment of the issue fee or any outstanding balance thereof is not an acceptable reply in an application abandoned or patent lapsed for failure to pay the issue fee or any portion thereof.

Accordingly, to satisfy the required reply requirement of § 1.137(b), the Issue Fee (at the amount in effect on September 24, 2003) has been charged to Deposit Account No. 10-0435, as authorized. Petitioners have met all requirements for a grantable petition under 37 CFR 1.137(b).

Petitioner is advised that the issue fee cannot be refunded. If, however, the above-identified application is again allowed, petitioner may request that it be applied towards the issue fee required by the new Notice of Allowance¹

As petitioner is aware, prosecution of this application has continued. This petition is being granted to close the gap in prosecution.

Technology Center AU 1625 has been advised of this decision reviving the application. The application has thereby been forwarded to TC 1625 for appropriate action.

Telephone inquiries related to this decision should be directed to the undersigned at (571) 272-3219.


Nancy Johnson
Senior Petitions Attorney
Office of Petitions

¹ The request to apply the issue fee to the new Notice may be satisfied by completing and returning the new Issue Fee Transmittal Form PTOL-85(b), which includes language to the effect that: "Commissioner for Patents is requested to apply the Issue Fee and Publication Fee (if any) or re-apply any previously paid Issue Fee to the application identified above." Petitioner is advised that, whether a fee is indicated as being due or not, the Issue Fee Transmittal Form **must** be completed and timely submitted to avoid abandonment. Note the language in bold text on the first page of the Notice of Allowance and Fee(s) Due (PTOL-85).